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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,195	02/19/2002	Michael Paul Bouchette	6497	6854
7590	10/08/2003		EXAMINER	
Benjamin Mieliulis Law Department Appleton Papers Inc. P.O. Box 359 Appleton, WI 54912-0359			BEFUMO, JENNA LEIGH	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/078,195	<b>Applicant(s)</b> BOUCHETTE ET AL.	
	<b>Examiner</b> Jenna-Leigh Befumo	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4,6-10 and 14 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention: 1) a nonwoven laminate having a fractured film layer as the additional layer (claims 5 – 7 and 14) and 2) a nonwoven laminate having a batting layer as the additional layer (claims 11 – 13).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 – 4 and 8 – 10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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2. During a telephone conversation with Benjamin Mieliulis on August 22, 2003 a provisional election was made with traverse to prosecute the invention having the film layer as the additional layer, claims 1 – 10 and 14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11 – 13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: 11, mentioned on page 22 of the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to because the description in the specification on page 22, lines 21 – 22 is unclear. The disclosure states that “a resilient material such as a stretchable elastomeric 1 and 3 is provided for snugly securing the footwear.” Are both reference numbers 1 and 3 suppose to represent the stretchable elastomeric material? If so, reference number 1 has already been used to refer to the stitching, and can not be used again. Otherwise the description is awkward and it is unclear why both reference numbers 1 and 3 are used in the sentence. A proposed drawing correction or corrected drawings are required in reply to the Office action to

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avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

6. The disclosure is objected to because of the following informalities: On page 18, line 18, should the US Patent the Applicant is referring to be 194,299 or 5,194,299 instead? US 194,299 does not teach adhesion values for various materials.

Appropriate correction is required.

***Claim Objections***

7. Claims 1, 6, 8, and 10 are objected to because of the following informalities: the phrase "as per the method described in Example 1" is not proper since it refers directly to the specification. It is suggested that the Applicant remove this limitation since the method to measure the drag force is described in the Specification. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 8 – 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 8 recites the limitation "the covering layer" in line 9. There is insufficient antecedent basis for this limitation in the claim. What is the covering layer? Claim 9 is rejected due to its dependency on claim 8.

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11. Claim 8 recites the limitation "said edges forming the opening" in lines 13. There is insufficient antecedent basis for this limitation in the claim. Even though the Applicant has previously mention the edges of the panels, this is not sufficient to define "said edges forming the opening" since the edges forming the opening are separate from the edges of the panels that have been sewn together to form the shoe cover. Thus, the Applicant needs to better define how the panel edges are different from the opening edges. Claim 10 is similarly rejected. Claims 9 and 14 are rejected due to their dependency on claim 8 or 10.

12. Claim 10 is recites the limitation "the first covering layer" in line 10. There is insufficient antecedent basis for this limitation in the claim. While the Applicant defines a covering layer, the Applicant doesn't not recite that there are multiple covering layers or what "the first covering layer" is and how it is related to the covering layer set forth earlier in the claims. Claim 14 is rejected due to its dependency on claim 10.

13. Finally, while claims 11 – 13 are not currently being considered in the rejection, should claim 10 be allowable claims 11 – 13 will also be allowable. Therefore, it is noted that the phrase "the batting material" in claims 12 and 13 does not have proper antecedent basis. Further, in claim 13 the phrase " the covering layer and nonwoven layer" is vague since in claim 10 the nonwoven layer is defined as part on the covering layer. Is this just redundant or is the Applicant reciting that a nonwoven layer separate from the covering layer, and separate from the second layer of nonwoven material is present in the laminate?

***Claim Rejections - 35 USC § 102/103***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1 – 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DeProspero et al. (5,639,539).

DeProspero et al. discloses a releasable covering comprising a reinforcing backing layer with a surfacing layer formed on the front surface of the reinforcing backing layer and a layer of printing applied onto the surfacing layer (abstract). A pressure sensitive adhesive layer formed of polymeric microspheres is applied to the rear surface of the backing layer (abstract). The pressure sensitive adhesive layer comprises tacky polymeric microspheres comprise a tacky polymeric material (column 2, lines 62 – 64). The reinforcing layer can be made from nonwoven fabrics such as nonwoven scrims, spunbonded fabrics, and the like (column 3, lines 11 – 15). Therefore, the nonwoven reinforcing layer is coated with microcapsules having adhesive on one side and additional coating layers are laminated to the other surface of the nonwoven fabric.

Although DeProspero et al. does not explicitly teach the average drag force of the adhesive layer, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. a layer of tacky polymeric microspheres) and in the similar production steps (i.e. applying the adhesive layer to the nonwoven fabric) used to produce the wall covering which is designed to be placed on the wall without falling or sliding off. The burden is upon the Applicant to prove otherwise. *In re*

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*Fitzgerald*, 205 USPQ 594. In the alternative, the claimed drag force would obviously have been provided by the process disclosed by DeProspero et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 1 and 4 are rejected.

With respect to claims 2 and 3 these claims only recite the intended use of the product recited in claim 1, and fail to add any further structural limitations to the product itself. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus, claims 2 and 3 are rejected.

17. Claims 1 – 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kesti et al. (5,824,748).

Kesti et al. discloses a composite comprising pressure sensitive adhesive microspheres (abstract). The pressure sensitive adhesive can be applied to various backings including films, woven fabrics, and nonwoven fabrics (column 9, lines 10 – 25). Therefore, Kesti et al. discloses a nonwoven fabric coated with adhesive microspheres.

Although Kesti et al. does not explicitly teach the average drag force of the adhesive layer, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. a layer of tacky polymeric microspheres) and in the similar production steps (i.e. applying the adhesive layer to the nonwoven fabric) used to produce a repositionable adhesive composite. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed drag force would obviously have been provided by the process disclosed by Kesti et al. Note *In*



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*re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 1 and 4 are rejected.

With respect to claims 2 and 3 these claims only recite the intended use of the product recited in claim 1, and fail to add any further structural limitations to the product itself. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus, claims 2 and 3 are rejected.

18. Claims 1 – 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Delgado et al. (5,908,693).

Delgado et al. discloses a wound dressing comprising a moisture vapor permeable backing and a particulate adhesive layer comprised of tacky, pressure sensitive adhesive microspheres (abstract). The moisture vapor permeable wound dressing backing can comprise a nonwoven fabric or a moisture vapor permeable films (column 3, lines 18 – 44).

Although Delgado et al. does not explicitly teach the average drag force of the adhesive layer, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. a layer of tacky polymeric microspheres) and in the similar production steps (i.e. applying the adhesive layer to the nonwoven fabric) used to produce a releasable medical composite. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed drag force would obviously have been provided by the process disclosed by Delgado et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35

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USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 1 and 4 are rejected.

With respect to claims 2 and 3 these claims only recite the intended use of the product recited in claim 1, and fail to add any further structural limitations to the product itself. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus, claims 2 and 3 are rejected.

***Claim Rejections - 35 USC § 103***

19. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delgado et al. in view of McKnight (4,561,435).

The features of Delgado et al. have been set forth above. Delgado et al. fails to teach bonding another layer to the adhesive coated film or nonwoven layer. McKnight is drawn to a wound dressing. McKnight discloses that the wound dressing comprises an absorbent pad **10** having at least one nonwoven layer (column 2, lines 59 – 66). An elastic film or fabric **14** coated with an adhesive layer **15** is bonded to the periphery of the absorbent pad so that the pad can be applied to a wound and form a protective barrier for the wound (column 3, lines 35 – 55). Therefore, it would have been obvious to one of ordinary skill in the art to use a wound dressing structure comprising an absorbent nonwoven pad as taught by McKnight et al. in the wound dressing taught by Delgado et al. so that the wound dressing would be able to protect the wound as well as absorb wound exudates. Thus, the composite would produce a breathable film layer coated with a microcapsule containing adhesive, which is bonded to a nonwoven fabric layer.

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Further, while Delgado et al. discloses that the film layer should be a moisture permeable layer, Delgado et al. fails to teach using a breathable film layer which is formed by forming microporous fractures in the film which allow the film layer to be breathable. However, it would have been obvious to one having ordinary skill in the art to choose a fractured film layer as the breathable film layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. One of ordinary skill would be motivated to use a fractured film layer which allows moisture to pass through the film while preventing liquids from passing through the film, since this film layer would produce a barrier layer which would protect the wound as well.

Although the limitations of drag force and vapor transmission rate measured in units of  $\text{g/m}^2$  are not explicitly taught by Delgado et al. or McKnight et al., it is reasonable to presume that said limitations would be met by the combination of the two references. Support for said presumption is found in the use of similar materials (i.e. breathable film layers and microcapsule adhesives) and in the similar production steps (i.e. applying the adhesive to a breathable film layer) used to produce the releasable medical composite. The burden is upon the Applicant to prove otherwise. And with respect to the intended use of the laminate, i.e., forming disposable footwear, this limitation is not consider a positive recitation, since the Applicant does not claim the structure of the footwear and is not given patentable weight at this time. Thus, claims 6 and 7 are rejected.

***Allowable Subject Matter***

20. Claims 8 – 10, and 14 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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21. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or fairly suggest a nonwoven laminate which comprises a microcapsule adhesive coating on one side of the laminate and a breathable synthetic material on the opposite side of the laminate. Further, the prior art fails to teach or fairly suggests a shoe covering which comprises a nonwoven fabric coated on the outside of the covering with a microcapsule adhesive to produce an anti-slip coating.

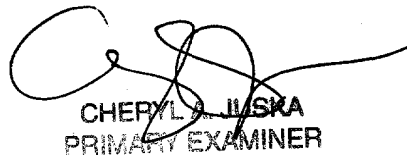
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo  
September 30, 2003



CHERYL A. JILKA  
PRIMARY EXAMINER